

Attorney's Docket No.: 10449-027001
Client's Ref. No.: P1S2000216US

OFFICIAL COMMUNICATION FACSIMILE:**OFFICIAL FAX NO: (703) 872-9306****RECEIVED
CENTRAL FAX CENTER**

Number of pages including this page

6

MAR 17 2005

Applicant : Koji Hayashi
Serial No. : 09/718,164
Filed : November 21, 2000

Art Unit : 2653
Examiner : Tan Xuan Dinh

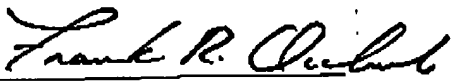
Title : DATA RECORDER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attached to this facsimile communication cover sheet is a Petition for Suspension of
Action, faxed this 17th day of March, 2005, to the United States Patent and Trademark Office.

Respectfully submitted,

Date: March 17, 2005

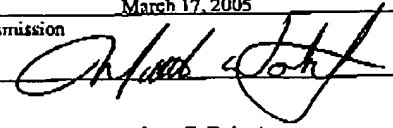

Frank R. Occhiuti
Reg. No. 35,306

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Fax: (617) 542-8906

21049335.doc

CERTIFICATE OF TRANSMISSION BY FACSIMILE

I hereby certify that this correspondence is being transmitted by
facsimile to the Patent and Trademark Office on the date indicated
below.

March 17, 2005
Date of Transmission
Signature 
Matthew G. Doherty
Typed or Printed Name of Person Signing Certificate

Attorney's Docket No.: 10449-027001 / P1S2000216US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
CENTRAL FAX CENTER

Applicant : Koji Hayashi
Serial No. : 09/718,164
Filed : November 21, 2000
Title : DATA RECORDER

Art Unit : 2653
Examiner : Tan Xuan Dinh

MAR 17 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF PETITION FOR SUSPENSION OF ACTION UNDER 35 CFR §1.103

Applicant petitions for suspension of action in the above-referenced application.

Applicant's claims were provisionally rejected as being unpatentable over claims of copending Application No. 09/717/771 (The '771 application) under the judicially-created doctrine of obviousness-type double patenting. Application submitted with their reply to the office action mailed November 5, 2004, an unsigned terminal disclaimer and noted:

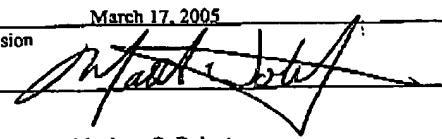
"To address the provisional obviousness-type double patenting rejections, we are submitting herewith an unsigned terminal disclaimer that the applicant (or his representative) are prepared to execute if the '771 application proceeds to grant prior to allowance and grant of the claims in the instant application."

The Examiner issued an Advisory Action mailed February 17, 2005 indicating that the application was not in condition for allowance because the terminal disclaimer was unsigned and the associate fee was not included (see attached).

Applicant's representative, the undersigned, has had several discussions with Examiner Tan Xuan Dinh to discuss the appropriateness of filing a terminal disclaimer for an application in which the claims are rejected on the basis of provisional obviousness-type double patenting grounds. On March 15, 2005, Examiner Dinh suggested that application petition for suspension of action under 37 CFR §1.103 and allow prosecution of the '771 application to proceed to grant

CERTIFICATE OF TRANSMISSION BY FACSIMILE

I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on the date indicated below.

March 17, 2005
Date of Transmission
Signature 
Matthew G. Doherty
Typed or Printed Name of Person Signing Certificate

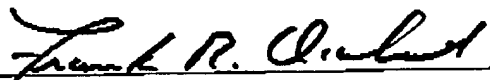
Applicant : Koji Hayashi
Serial No. : 09/718,164
Filed : November 21, 2000
Page : 2 of 2

Attorney's Docket No.: 10449-
027001 / P1S2000216US

or abandonment. In accordance with the Examiner's suggestion, applicant is filing this petition and, in light of the non-extendible statutory deadline of May 5, 2005, requests expedited consideration. Please apply the charge of \$200.00 for the associated petition fee under 37 CFR §1.17(h) to our Deposit Account 06-1050.

Respectfully submitted,

Date: March 17, 2005


Frank R. Occhiuti
Reg. No. 35,306

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

21047662.doc

FRO



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/718,164 | 11/21/2000 | Koji Hayashi | 10449-027001 | 8739 |
| 26161 | 7590 | 02/17/2005 | EXAMINER | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | DINH, TAN X | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2653 | |

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

NOTICE OF APPEAL 5/5/05

JOF 2/22/05

RECEIVED

FEB 22 2005

FISH & RICHARDSON, P.C.
BOSTON OFFICE

Advisory Action Before the Filing of an Appeal Brief

Application No.

09/718,164

Applicant(s)

HAYASHI, KOJI

Examiner

TAN X. DINH

Art Unit

2653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-13.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☒ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☒ Other: See Continuation Sheet.

TAN Xuan DINH
Primary Examiner
Art Unit: 2653

Continuation Sheet (PTOL-303)

Application No.

Continuation of 11. does NOT place the application in condition for allowance because: The Terminal Disclaimer is not acceptable since it does not include fee and/or signatures.

Continuation of 13. Other: The IDS filed after the Final Office action on 12/22/2004 and 1/31/2005 will not be considered at this time..